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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,521	11/28/2001	Paul Moroney	018926-008200US	5019

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EXAMINER

HENNING, MATTHEW T

ART UNIT PAPER NUMBER

2131

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/997,521	Applicant(s) MORONEY, PAUL	
	Examiner Matthew T. Henning	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1 This action is in response to the communication filed on 11/23/2005.

2 **DETAILED ACTION**

3 *Response to Arguments*

4 The Declaration filed on 11/23/2005 under 37 CFR 1.131 has been considered but is
5 ineffective to overcome the Jones reference.

6 The evidence submitted is insufficient to establish a conception of the invention prior to
7 the effective date of the Jones reference. While conception is the mental part of the inventive
8 act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure
9 to another. Conception is more than a vague idea of how to solve a problem. The requisite
10 means themselves and their interaction must also be comprehended. See *Mergenthaler v.*
11 *Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Statement (3) of the declaration states
12 that the claimed invention was conceived prior to December 31, 2002. Although the documents
13 presented in Appendix A support this allegation, conception prior to December 31, 2002 does not
14 antedate the Jones reference. For this and the reasons presented below, the declaration is
15 insufficient. See MPEP 715.07.

16 The evidence submitted is insufficient to establish a reduction to practice of the invention
17 in this country or a NAFTA or WTO member country prior to the effective date of the Jones
18 reference (July 10th, 2001). Statement (4) of the declaration states that the documents presented
19 in Appendix A support a constructive reduction to practice. However, constructive reduction to
20 practice occurs when the application is filed with the office, not when an Invention Record Form
21 is submitted to a law department. See MPEP 715.07 III. Instead, the evidence presented in

Appendix A appears to show *conception* of the invention as claimed and not constructive reduction to practice. As such, the declaration is ineffective.

Please see MPEP § 715 for information regarding proper declarations under 37 CFR 1.131.

Because the declaration under 37 CFR 1.131 has been found insufficient to antedate the Jones reference, the prior art rejections presented in the office action dated 3/2/2005 have been maintained.

Claims 1-36 have been examined.

All objections and rejections not presented below have been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-9, 18-22, 25-31, and 33 -36 are rejected under 35 U.S.C. 102(e) as being anticipated by Jones (US Patent Application Publication 2003/0016825).

Regarding claim 1, Jones disclosed a theater complex domain comprising (See Jones Fig. 4): a projection unit operable to render decompressed digital video content (See Jones Paragraph 0027); a security module having a decompression unit operable to receive compressed digital

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1 video content and to produce the decompressed digital video content (See Jones Paragraphs 0025
2 and 0029); the compressed digital video content received by the decompression unit comprises
3 unencrypted compressed digital video content, and the decompressed digital video content
4 rendered by the projection unit comprises unencrypted decompressed high bit-rate digital video
5 content (See Jones Col. 0025); and the security module having a decryption unit for receiving
6 encrypted compressed digital video content and to produce the unencrypted compressed digital
7 video content (See Jones Paragraph 0025).

8 Regarding claim 2, Jones disclosed that the security module further comprises: a
9 watermark unit coupled to the decompression unit operable to receive the decompressed digital
10 video content produced by the decompression unit and to produce the decompressed digital
11 video content rendered by the projection unit, wherein the decompressed digital video content
12 rendered by the projection unit includes a watermark embedded therein (See Jones Paragraph
13 0025).

14 Regarding claim 3, Jones disclosed that the watermark uniquely identifies the projection
15 unit to which the security module is removably coupled (See Jones Paragraph 0034 Lines 3-7).

16 Regarding claim 4, Jones disclosed that the security module is physically locked in a
17 tamper resistant container (See Jones Paragraph 0023).

18 Regarding claim 5, Jones disclosed that the security module is physically locked to the
19 projection unit to which it is removably coupled (See Jones Paragraphs 0023 and 0029).

20 Regarding claim 7, Jones disclosed a receiver coupled to the security module operable to
21 receive the compressed digital video content from a content source (See Jones Paragraph 0024).

1 Regarding claim 8, Jones disclosed that the receiver is operable to receive the compressed
2 digital video content from the content source in real-time, and is operable to transmit the
3 compressed digital video content to the security module, such that the projection unit renders
4 digital video content corresponding to the compressed digital video content nearly concurrently
5 with reception by the receiver of the compressed digital video content (See Jones Paragraphs
6 0024-0025 and 0032).

7 Regarding claim 9, Jones disclosed a file server coupled to the receiver and the security
8 module, the file server being operable to store the compressed digital video content received
9 from the receiver, and being operable at a later time or times to provide the compressed digital
10 video content to the security module for rendering by the projection unit; wherein the receiver is
11 operable to receive the compressed digital video content from the content source, and is operable
12 to transmit the compressed digital video content to the file server (See Jones Paragraph 0032).

13 Regarding claim 18, Jones disclosed a security module for a projection unit, comprising:
14 a decompression unit operable to receive compressed digital video content and to produce
15 decompressed digital video content; and a security container coupled to and enclosing the
16 decompression unit, wherein the security container is physically removably coupled to the
17 projection unit (See Jones Paragraphs 0025-0027, and 0029).

18 Regarding claim 19, Jones disclosed a watermarking unit for producing decompressed
19 digital video content having a watermark embedded therein (See Jones Paragraph 027).

20 Regarding claim 20, Jones disclosed the watermark embedded in the decompressed
21 digital video content produced by the watermarking unit uniquely identifies the projection unit to
22 which the security module is removably coupled (See Jones Paragraph 0034).

1 Regarding claim 21, Jones disclosed the watermark embedded in the decompressed
2 digital video content produced by the watermarking unit uniquely identifies the security module
3 (See Jones Paragraph 0034 and Paragraph 0029).

4 Regarding claim 22, Jones disclosed that the compressed digital video content received
5 by the decompression unit comprises unencrypted compressed digital video content, and wherein
6 the decompressed video content produced by the decompression unit comprises unencrypted
7 decompressed video content, the security module further comprising: an encryption unit coupled
8 to the decompression unit operable to receive encrypted compressed digital video content and to
9 produce the unencrypted compressed digital video content (See Jones Paragraph 0025).

10 Regarding claim 25, Jones disclosed a method of displaying digital video content, the
11 method comprising the steps of: receiving compressed digital video content from a content
12 source; transmitting the compressed digital video content to a security module removably
13 coupled to a projection unit; decompressing the compressed digital content within the security
14 module so as to produce decompressed digital video content; and rendering the decompressed
15 digital video content by the projection unit (See Jones Paragraphs 0024-0027).

16 Regarding claim 26, Jones disclosed that compressed digital video content from the
17 content source comprises encrypted compressed digital video content, wherein the compressed
18 digital video content decompressed within the security module comprises unencrypted
19 compressed digital video content, the method further comprising the steps of: decrypting the
20 encrypted compressed digital video content so as to produce the unencrypted compressed digital
21 video content (See Jones Paragraphs 0024-0025).

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1 Regarding claim 27, Jones disclosed after the transmitting and prior to the rendering step,
2 watermarking within the security module the digital video content with an embedded watermark
3 (See Jones Paragraph 0026).

4 Regarding claim 28, Jones disclosed that the embedded watermark comprises a unique
5 identifier of the projection unit to which the security module is removably coupled (See Jones
6 Paragraph 0034).

7 Regarding claim 29, Jones disclosed that the embedded watermark comprises a unique
8 identifier of the security module (See Jones Paragraphs 0029 and 0034).

9 Regarding claim 30, Jones disclosed that the receiving of the digital video content from
10 the content source occurs in real-time nearly concurrently with the rendering of the
11 decompressed digital video content by the projection system (See Jones Paragraph 0032).

12 Regarding claim 31, Jones disclosed after the receiving step and prior to the transmitting
13 step, storing in a file server the compressed digital video content (See Jones Paragraph 0032).

14 Regarding claim 33, Jones disclosed that the watermark unit is coupled before or after the
15 decompression unit (See Jones Figs. 3-4).

16 Regarding claim 34, Jones disclosed a decryption unit for receiving encrypted
17 compressed digital video content and to produce the unencrypted compressed digital video
18 content (See Jones Paragraph 0025).

19 Regarding claim 35, Jones disclosed A method for secure delivery and playback of
20 content between a studio computing system and theater computing system, the method
21 comprising: encrypting the content at the studio computing system (See Jones Paragraph 0002
22 and 0024); forwarding the encrypted content from the studio computing system to a theater

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1 computing system (See Jones Paragraph 0002 and 0024); storing by the theater computing
2 system, the encrypted content in memory (See Jones Paragraph 0032); playback of the encrypted
3 content from the theater computing system to a projection unit (See Jones Paragraph 0032); and
4 decryption of the encrypted content at a secure module located within a projection unit such that
5 the act of decrypting is controlled at the studio computing system and the act of play back is
6 controlled by the theater computing system (See Jones Paragraphs 0006, 0028 and 0032).

7 Regarding claim 36, Jones disclosed that the secure module is a single replaceable unit
8 (See Jones paragraph 0028).

9 ***Claim Rejections - 35 USC § 103***

10 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
11 obviousness rejections set forth in this Office action:

12 *A patent may not be obtained though the invention is not identically disclosed or*
13 *described as set forth in section 102 of this title, if the differences between the subject matter*
14 *sought to be patented and the prior art are such that the subject matter as a whole would have*
15 *been obvious at the time the invention was made to a person having ordinary skill in the art to*
16 *which said subject matter pertains. Patentability shall not be negated by the manner in which*
17 *the invention was made.*
18

19 Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones as applied to
20 claim 1 above, and further in view of Lemelson et al. (US Patent Number 5,731,785) hereinafter
21 referred to as Lemelson.

22 Jones disclosed a lock box system for decrypting, decompressing, watermarking and
23 projecting video content (See Jones Paragraph 0024-0028) and also that the box had tamper
24 detection (See Jones Paragraph 0028), but Jones failed to disclose the system having a global
25 positioning circuit embedded within it.

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1 Lemelson teaches a system for embedding a global positioning system in an object as a
2 means for tracking the object in the event that it is stolen (See Lemelson Col. 1 Lines 25-57, and
3 Col. 5 Lines 37-50).

4 It would have been obvious to the ordinary person skilled in the art at the time of
5 invention to employ the teachings of Lemelson in the secure locked box of Jones by adding a
6 GPS tracking system in the box which can signal a central location with location information.
7 This would have been obvious because the ordinary person skilled in the art would have been
8 motivated to provide protection of the secure box in the event that the box was stolen.

9 Claims 10-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Jones as
10 applied to claim 1 above, and further in view of Rabowsky (US Patent Number 6,141,530).

11 Jones disclosed receiving video content from a remote source (See Jones Paragraph 0024)
12 but failed to disclose how the remote source was connected to the receiver.

13 Rabowsky teaches cinema and data files can be delivered to a theater system via a
14 satellite communication link, a coaxial cable, or a fiber optic cable (See Rabowsky Col. 8 Lines
15 43-50).

16 It would have been obvious to the ordinary person skilled in the art at the time of
17 invention to employ the teachings of Rabowsky in the theater system of Jones by sending the
18 content to the theater via a satellite or fiber optic link. This would have been obvious because
19 the ordinary person skilled in the art would have been motivated to provide a means for sending
20 the content from the provider to the theater.

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1 Claims 12-13, 23, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over
2 Jones as applied to claim 1, 18, and 25 respectively above, and further in view of Schiller et al.
3 (US Patent Number 5,499,046) hereinafter referred to as Schiller.

4 Regarding claims 12 and 32, Jones disclosed sending video content from a remote
5 location to a theater (See Jones Paragraph 0024) but failed to disclose sending the content in IP
6 packet format.

7 Schiller teaches that by sending video content in TCP/IP packet format, any lost or
8 dropped packets can be recognized and retransmitted (See Schiller Col. 7 Paragraphs 4-6 and
9 Col. 8 Paragraph 5).

10 It would have been obvious to the ordinary person skilled in the art at the time of
11 invention to employ the teachings of Schiller in the content receiving system of Jones by
12 providing the content in the form of TCP/IP Packets. This would have been obvious because the
13 ordinary person skilled in the art would have been motivate to provide a means to detect missing
14 packets from the content in order for the content to be assembled correctly.

15 Regarding claims 13 and 23, Jones also failed to disclose a transmitter with the ability to
16 transmit information to the content source.

17 Schiller further teaches that in a content receiving system, the receiver should send
18 requests to the content provider in the event that certain packets need to be re-transmitted.

19 It would have been obvious to the ordinary person skilled in the art at the time of
20 invention to employ the teachings of Schiller in the content receiving system of Jones by
21 providing a transmitter to send requests for retransmission to the content provider. This would

1 have been obvious because the ordinary person skilled in the art would have been motivated to
2 receive all the movie content packets in order to properly reassemble the content.

3 Claim 14-17, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the
4 combination of Jones and Schiller as applied to claims 1 and 23 above respectively, and further
5 in view of Rabowsky (US Patent Number 6,141,530).

6 Regarding claims 14, 15 and 24, the combination of Jones and Schiller disclosed
7 detecting attempts to tamper with the secure box (See Jones Paragraph 0023), but failed to
8 disclose sending reports of tampering, or periodic reports, to the content source.

9 Rabowsky teaches that in a content providing system, the theater system can send
10 periodic status reports to the content provider, as well as urgent reports and trouble reports (See
11 Rabowsky Col. 12 Paragraph 4).

12 It would have been obvious to the ordinary person skilled in the art at the time of
13 invention to employ the teachings of Rabowsky in the theater system of Jones and Schiller by
14 having the secure box send periodic status reports, as well as urgent reports and trouble reports in
15 the event of tamper detection. This would have been obvious because the ordinary person skilled
16 in the art would have been motivated to provide a means for maintaining the health and welfare
17 of the theater system. Also, it would have been obvious and natural to send some form of an
18 alert message to the content provider in the event of tamper detection because the ordinary
19 person skilled in the art would have been motivated make the proper authorities aware of the
20 tampering, once it was detected.

21 Regarding claim 16, the combination of Jones, Schiller, and Rabowsky disclosed that the
22 transmitter and receiver were embedded in a transceiver unit (See the rejection of claim 13

1 above, and Schiller Col. 8 Paragraphs 4-5, wherein the theater system contains both a transmitter
2 and receiver, which constitutes a transceiver).

3 Regarding claim 17, the combination of Jones, Schiller, and Rabowsky disclosed that the
4 security module and transceiver are coupled together by an IP network (See the rejection of
5 claim 13 above, and Schiller Col. 9 Paragraph 6).

6 ***Conclusion***

7 Claims 1-36 have been rejected.

8 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
9 policy as set forth in 37 CFR 1.136(a).

10 A shortened statutory period for reply to this final action is set to expire **THREE**
11 **MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**
12 **MONTHS** of the mailing date of this final action and the advisory action is not mailed until after
13 the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period
14 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
15 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
16 however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing
17 date of this final action.

18 Any inquiry concerning this communication or earlier communications from the
19 examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.
20 The examiner can normally be reached on M-F 8-4.


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1 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
2 supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the
3 organization where this application or proceeding is assigned is 571-273-8300.

4 Information regarding the status of an application may be obtained from the Patent
5 Application Information Retrieval (PAIR) system. Status information for published applications
6 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
7 applications is available through Private PAIR only. For more information about the PAIR
8 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
9 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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